

REMARKS

Upon entry of this amendment, claims 2, 4-6 and 8-19 are all the claims pending in the application. By this Amendment, Applicant has canceled claims 1 and 7, amended claim 6, and rewritten claim 11 in independent form. Claim 5 has been withdrawn from consideration as being drawn to a non-elected species. Claims 12-19 have been added. No new matter has been added.

I. Request to Withdraw Finality of Office Action Dated April 9, 2003.

The Examiner indicated that the Office Action dated April 9, 2003 is a final Office Action. However, Applicant submits that the Office Action contains a new grounds of rejection that was not necessitated by an amendment made by Applicant.

Specifically, in the non-final Office Action dated September 17, 2002, claims 1-4 and 6 were rejected under 35 U.S.C. § 102(b) as being anticipated by Payr (U.S. Patent No. 5,179,883). Claims 2-4 and 6 each depended from claim 1.

In response to the non-final Office Action, Applicant filed an Amendment on January 17, 2003, in which claim 3 was canceled and the identical limitations thereof were incorporated into independent claim 1. Thus, amended claim 1 was identical to originally presented claim 3.

In response to the Amendment, the Examiner issued the present Office Action on April 9, 2003, wherein a new grounds of rejection was presented in rejecting the claims. Specifically, claims 1, 2 and 4 were rejected under 35 U.S.C. § 102(b) as being anticipated by Neal (U.S. Patent No. 1,435,252).

However, as amended claim 1 was identical to original claim 3, such an amendment clearly could not have necessitated the new grounds of rejection for this claim, as was suggested by the Examiner. Rather, it is clear that the new grounds of rejection was added by the Examiner due to the withdrawal of the primary rejection due to it being an improper rejection and not due to any amendment of the claims.

Further, MPEP § 706.07(a) states that a “second or subsequent action on the merits in any application ... should not be made final if it includes a rejection, on prior art not of record, of any claim amended to include limitations which should reasonably have been expected to be claimed.” Applicant respectfully submits that amending independent claim 1 to include the features of dependent claim 3 was an amendment to include “limitations which should reasonably have been expected to be claimed.”

Based on the foregoing, Applicant respectfully submits that making the present Office Action final was improper and requests that the finality of the Office Action be withdrawn. If the Examiner maintains the finality of the Office Action, Applicant respectfully requests an explanation as to how Applicant’s Amendment necessitated the new grounds of rejection.

II. Drawings

The Examiner has maintained the objection to Figs. 7 and 8. The Examiner is apparently under the belief that the cutting machines (i.e., elements 7, 8 and 9) in Figs. 7 and 8 (second embodiment) are modifications of the cutting machines (i.e., elements 7, 8 and 9) as shown in

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Figs. 1 to 4B (first embodiment). Therefore, the Examiner asserts that the elements in Figs. 7 and 8 should be labeled with different reference numerals.

Contrary to the assertion of the Examiner, however, the cutting machines in Figs. 7 and 8 (i.e., elements 7, 8 and 9) are the identical cutting machines (i.e., elements 7, 8 and 9) as shown in Figs. 1 to 4B. Indeed, the specification particularly states on page 14, lines 5-6 that:

“In this embodiment of Figs. 7 and 8, a plurality of identical cutting machines A of the structure shown in and described with reference to Figs. 1 to 4B are utilized...”

Therefore, Applicant submits that elements 7, 8 and 9 are identical in the first and second embodiments and, therefore, do not need to be labeled with different reference numerals. Accordingly, the Examiner is requested to reconsider and withdraw the objection to the drawings.

III. Claim Rejections under 35 U.S.C. § 102(b)

Claims 1, 2, 4 and 7-10 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Neal (U.S. Patent No. 1,435,252).

Independent claims 1 and 7 have been canceled. Dependent claims 2, 4 and 8-10 have been amended so as to depend from independent claims 6 and 11. Applicant submits that claims 6 and 11 are patentable for the reasons set forth below. Accordingly, Applicant submits that dependent claims 2, 4 and 8-10 are patentable at least by virtue of their dependency.

IV. Claim Rejections under 35 U.S.C. § 103(a)

Claims 6 and 11 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Neal (U.S. Patent No. 1,435,252) in view of Scott (U.S. Patent No. 5,287,782). Applicants respectfully traverse this rejection on the following basis.

Claim 6 defines a novel combination of features which forms a cutting machine. Included among the features of this new machine is a retaining mechanism for pressing a portion of the flat cardboard plate against the support table by moving a retainer bar only in a vertical direction to retain the flat cardboard plate immovable during a cutting operation. Applicant submits that the claimed combination, including at least this feature, is neither taught nor suggested by Neal in view of Scott.

The Examiner recognizes that Neal does not disclose the feature of a retaining mechanism which retains the flat cardboard plate immovable during a cutting operation. To cure this deficiency, the Examiner applies Scott and asserts that Scott teaches such a feature. Applicant respectfully disagrees.

Scott discloses a retaining mechanism 80 which stabilizes a board as it travels through the machine and is cut by a plurality of saws (see Figs. 1 and 2; see column 5, lines 20-22). Therefore, as is clearly disclosed by Scott, the retaining mechanism 80 does not retain the board immovable during a cutting operation, as is required by claim 6.

Rather, retaining mechanism 80 merely stabilizes the board as it moves through the machine and undergoes a cutting operation. Scott discloses saws which are stationary and, therefore, the boards must move through the machine in order for the boards to be cut. Thus, the

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boards in Scott are clearly movable, not immovable. Indeed, if retaining mechanism 80 rendered the boards immovable, the sawing machine as disclosed by Scott would be fully inoperable.

In addition, claim 6 recites that the flat cardboard plate is rendered immovable during a cutting operation by a retainer bar which moves only in a vertical direction. Applicant submits that neither Neal nor Scott even remotely suggest a retainer bar which moves only in a vertical direction to retain the flat cardboard plate immovable during a cutting operation, as specifically recited in claim 6.

Therefore, as the combination of Neal and Scott fails to teach or suggest all of the features of claim 6, Applicant submits that a prima facie case of obviousness has not been established and respectfully requests that the Examiner reconsider and withdraw the rejection.

Applicant submits that claim 11 is patentable for similar reasons as discussed above regarding claim 6. Namely, the combination of Neal and Scott fails to teach or suggest the feature of a retaining mechanism which renders an article immovable during a cutting operation. Accordingly, Applicant respectfully requests that the rejection be reconsidered and withdrawn.

Furthermore, claim 5 has been amended so as to depend from claim 6. Accordingly, Applicant submits that claim 5 is patentable at least by virtue of its dependency and respectfully requests the Examiner to rejoin the claim upon the allowance of claim 6.

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V. New Claims

New claims 12-19 are added. Applicant submits that these claims are patentable over the cited prior art based on the combination of features recited therein.

VI. Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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PATENT TRADEMARK OFFICE

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APPENDIX

VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE CLAIMS:

Claims 1 and 7 are canceled

The claims are amended as follows:

2. (Once Amended) The cutting machine for cutting the flat cardboard plate as claimed in Claim [1] 6, wherein each of the first and second rotary cutters rotates in such a direction as to permit a leading portion of the respective rotary cutter, with respect to a direction of movement relative to the flat cardboard plate, to plunge into the flat cardboard plate.

4. (Twice Amended) The cutting machine for cutting the flat cardboard plate as claimed in Claim [1] 6, wherein the level adjusting mechanism is operable to selectively elevate and lower the support table.

5. (Once Amended) The cutting machine for cutting the flat cardboard plate as claimed in Claim [1] 6, further comprising a support structure for rotatably supporting the first and second rotary cutters and wherein the drive mechanism is operable to move the support structure relative to the flat cardboard plate.

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6. (Twice Amended) [The] A cutting machine for cutting [the] a flat cardboard plate [as claimed in Claim 1, further comprising] having a cardboard, said cutting machine comprising:

a first rotary cutter for cutting an upper portion of the flat cardboard plate;

a second rotary cutter rotatable in a direction counter to a direction of rotation of the first rotary cutter for cutting a lower portion of the flat cardboard plate;

a drive mechanism for driving the first and second rotary cutters relative to the flat cardboard plate along a single cutting line to cut the flat cardboard plate along such cutting line;

a support table for supporting from below the flat cardboard plate, and a level adjusting mechanism for adjusting a relative position between the support table and the first and second rotary cutters in a direction up and down according to a thickness of the flat cardboard plate to be cut and for setting a boundary between respective depth of cutting by the first and second rotary cutters to a value substantially equal to one half of a thickness of the flat cardboard plate; and

a retaining mechanism for pressing a portion of the flat cardboard plate on a trailing side of the cutting line with respect to a direction of feed of the flat cardboard plate against the support table by moving a retainer bar only in a vertical direction to retain the flat cardboard plate immovable during a cutting operation.

8. (Once Amended) The cutting machine as claimed in Claim [7] 11, wherein the adjusting mechanism is further operable to set a boundary between respective depth of cutting by

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the first and second rotary cutters to a value substantially equal to one half of a thickness of the article.

9. (Once Amended) The cutting machine as claimed in Claim [7] 11, wherein each of the first and second rotary cutters rotates in such a direction as to permit a leading portion of the respective rotary cutter, with respect to a direction of movement relative to the article, to plunge into the article.

10. (Once Amended) The cutting machine as claimed in Claim [7] 11, wherein the level adjusting mechanism is operable to selectively elevate and lower the support table.

11. (Once Amended) A [The] cutting machine [as claimed in Claim 7, further] comprising:

a first rotary cutter operable to cut an upper portion of an article;

a second rotary cutter which rotates in a direction counter to a direction of rotation of the first rotary cutter and operable to cut a lower portion of the article;

a drive mechanism operable to drive the first and second rotary cutters relative to the article along a single cutting line to cut the article along such cutting line;

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a support table operable to support from below the article, and a level adjusting mechanism operable to adjust a relative position between the support table and the first and second rotary cutters in a vertical direction according to a thickness of the article to be cut; and

a retaining mechanism operable to press a portion of the article on a trailing side of the cutting line with respect to a direction of feed of the article against the support table to retain the article immovable during a cutting operation.

Claims 12 through 19 are added as new claims: